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OFFICE OF PETITIONS

In re Application of
Nishida et al.
Application No. 08/295686
Filing or 371(c) Date: 08/24/1994
Attorney Docket Number: 52433354

DECISION
ON PETITION

This is a decision on the "Petition to Revive Patent Application Unavoidably Abandoned Under 37 CFR 1.137(a), filed August 22, 2008, to revive the above-identified application. The delay in treating this petition is regretted.

This Petition is hereby **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under [insert the applicable code section]". This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed March 24, 1995. The Office action set a extendable three (3) month period for reply. Extensions of time were available under 37 CFR 1.136(a). No complete and proper reply having been received, the application became abandoned on June 25, 1995. A Notice of Abandonment was mailed October 17, 1995.

The present petition (originally filed September 22, 1995 (Certificate of Mailing dated September 20, 1995))

Applicant files the present petition, and asserts that timely reply to the Office action, including a request for a three (3) month extension of time and fee, were filed on September 22, 1995 (Certificate of Mailing dated September 20, 1995). In support of this assertion, Applicant files a copy of the reply, and a copy of Applicant's return-receipt postcard acknowledging receipt by this Office of a Response and an Extension Request on September 22, 1995. A review of the

copy of the reply filed with the petition reveals that the reply contains a Certificate of Mailing under 37 CFR 1.8 dated September 20, 1995, and executed by Petitioner herein.

Office records do not indicate receipt of the reply on or about September 22, 1995, or the petition on or about November 7, 1995. Office records do, however, reveal that the fee for a three (3) month extension of time was received in this Office on September 22, 1995, and the fee for a petition to revive an application abandoned unavoidably was received in this Office on November 9, 1995.

The present petition is accompanied by a status request, requesting the status of the petition. No other communication regarding the status of the petition has been filed.

A Grantable Petition Under 37 CFR 1.137(a)

In November, 1995, the showing required for a grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

- (1) A proposed response to continue prosecution of the application, or the filing of a continuing application, unless either has been previously filed;
- (2) The petition fee as set forth in § 1.17(l); and
- (3) A showing that the delay was unavoidable. The showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

The present petition lacks item (3).

Applicable Law, Rules and MPEP

As to item (3), Applicant must provide a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. In order to determine whether the delay was unavoidable, the courts have adopted a "reasonably prudent person" standard. The courts have provided that:

The word unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath , 38 App. D.C. 497, 514-15 (1912)(quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139,

141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute “unavoidable” delay. See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm’r Pat. 130, 131 (1891). For example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not “unavoidable” when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. Likewise, as a “reasonably prudent person” would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant’s failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute “unavoidable” delay. See Krahn, 15 USPQ2d at 1825. Finally, a delay caused by an applicant’s lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered “unavoidable” due to: (A) the applicant’s reliance upon oral advice from USPTO employees; or (B) the USPTO’s failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm’r Pat. 1985).

35 U.S.C. 133 and 151 each require a showing that the “delay” was “unavoidable,” which requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay until the filing of a petition to revive. See In re Application of Takao, 17 USPQ2d 1155 (Comm’r Pat. 1990). The burden of continuing the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. *Id.* at 1158. Thus, an applicant seeking to revive an “unavoidably” abandoned application must cause a petition under 37 CFR 1.137(a) to be filed without delay (i.e., promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application).

An applicant who fails to file a petition under 37 CFR 1.137(a) “promptly” upon becoming notified, or otherwise becoming aware, of the abandonment of the application will not be able to show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. The removal of the language in 37 CFR 1.137(a) requiring that any petition thereunder be “promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment” should not be viewed as: (A) permitting an applicant, upon becoming notified, or otherwise becoming aware, of the abandonment of the application, to delay the filing of a petition under 37 CFR 1.137(a); or (B)

changing (or modifying) the result in *In re Application of S*, 8 USPQ2d 1630 (Comm'r Pat. 1988), in which a petition under 37 CFR 1.137(a) was denied due to the applicant's deliberate deferral in filing a petition under 37 CFR 1.137. An applicant who deliberately chooses to delay the filing of a petition under 37 CFR 1.137 (as in *Application of S*, 8 USPQ2d at 1632) will not be able to show that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to [37 CFR 1.137(a)] was unavoidable" or even make an appropriate statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to [37 CFR 1.137(b)] was unintentional."

Analysis

There is a question of whether an applicant's delay in prosecuting an application was unavoidable. Applicant timely filed a reply to the Office action, and timely filed a petition to revive the application based upon the timely filing of the reply; however, at issue is the delay in prosecuting the application. The period of delay in this instance is more than 12 years. The burden of continuing the process of presenting a grantable petition in a timely manner remains with the applicant until the applicant is informed that the petition is granted. See *In re Application of Takao*, 17 USPQ2d 1155, at 1158 (Comm'r Pat. 1990).

Applicant has also failed to demonstrate that Applicant exercised the diligence required in prosecuting his application. The applicant has the duty to make sure his application is being prosecuted. *Winkler v. Ladd*, 221 F. Supp. 550, 552 (D.D.C. 1962). Moreover, diligence on the part of the applicant is essential to show unavoidable delay. See, *Future Technology, Ltd. v. Quigg*, 684 F. Supp. 430, 431 (E.D. Va. 1988). Diligent inquiry into the status of the application is required. *Id.* The test for diligence is not whether the Applicant knew that the application was abandoned, but whether he exercised due diligence to find out and correct the problem. Applicant has not provided any explanation as to why a period of nearly 13 years passed without Applicant making any effort to find out about the status of the application and correct the problem.

Conclusion

Petitioner has failed to demonstrate that the delay in prosecuting an application was unavoidable.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
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